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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,326	07/30/2001	Tatsuya Ekinaka	OHS-304	2053

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Washington, DC 20006

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,326

Applicant(s)

EKINAKA ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/30/03 Response.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-9 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 3-5,9-12 and 19-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The Applicants' response filed on October 30, 2003 was received.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 9).

Claim Objections

3. Claims 9-12 are objected to because of the following informalities:
Should the definitions of the symbols in the following claims be explicitly expressed?
X, R⁵, R⁶ and n in Claim 9 (page 64, line 28) and Claim 10 (page 65, line 24)
Z, R¹⁰ and W in Claim 10 (page 65, line 29) and Claim 12 (page 68, line 4)
Y and R⁹ in Claim 11 (page 66, line 25) and Claim 12 (page 67, line 32)
R⁷, R⁸ and r in Claim 11 (page 66, line 32) and Claim 12 (page 68, line 11)

Claim Rejections - 35 USC § 102

4. Rejection of Claims 1-2, 6, 8 and 13-18 under 35 USC 102(b) as being anticipated by Nakayama (JP 59-109528) is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 9
5. Rejection of Claims 7 and 9 under 35 USC 103(a) as being unpatentable over Nakayama is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 9.

Responsive to arguments regarding 35 USC § 102 rejection

6. Applicant's arguments filed on October 30, 2003 have been fully considered but they are not persuasive.

The Applicants' principal argument against the rejection is that a) "Nakagawa fails to disclose an example in which a tetraalkoxysilane" is used in the top coat" (Remarks, page 5, 3rd paragraph); "Nakagawa fails to disclose or suggest an effect and advantage obtained by using a tetraalkoxysilane in the top coat" (Remark, page 5, 7th paragraph); and b) "Thus, since the second layer of the present invention comprises colloidal silica, trialkoxysilane and tetraalkoxysilane in a specific ratio, it has excellent abrasion resistance and weatherability. This effect of the present invention is neither disclosed nor suggested by Nakagawa. (Remarks, page 6, second paragraph)

Applicants' argument is not persuasive because of the following reasons:

With respect to a) Nakagawa does teach the use of tetraalkoxysilanes in the top coat as indicated in paragraph 6 of Paper 6, which Applicants also acknowledged (Remarks, page 4, last paragraph and page 5, first paragraph). Therefore, the present invention is anticipated by Nakagawa. Applicants should note that the argument that Nakagawa does not use any tetraalkoxysilane in examples for the top coat is irrelevant because examples are merely preferred embodiments.

With respect to b), as mentioned in the paragraph 6 of Paper 6, Nakayama does disclose a top coat comprises 55 to 62 wt% of A), 11 to 20 wt% of B) and 15 to 35 wt% of C), which reads on the top coat composition of the present invention. Therefore, both top coats should have the same properties. *In re Best*, 195 USPQ 430 (CCPA 1977).

Responsive to arguments regarding 35 USC § 103 rejection

7. Applicant's arguments filed on October 30, 2003 have been fully considered but they are not persuasive.

In view of the response to argument in the previous paragraph, Applicants do not overcome the 35 USC § 102 rejection, the 35 USC § 103 rejection against the dependent claims (i.e., Claims 7 and 9) is still adequate.

8. Claims 3-5, 10-12 and 19-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Nakayama does not teach or suggest the use of a) an acrylic copolymer resin containing units of formula (I-d) set forth in Claims 3, 10 and 12, b) a base coat being formed of a mixture of an acrylic resin with a hydrolysis condensate of a compound of formula (I-e) set forth in Claims 4, 11, 19 and 21-23 and c) a base coat being formed of a mixture of an acrylic resin, a hydrolysis condensate of a compound of formula (I-e) and a melamine resin set forth in Claims 5, 20 and 24-26.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
December 30, 2003


Kuo-Liang Peng
Primary Examiner
Art Unit 1712